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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/148,973	09/04/98	GREENAMYRE J	PC10023A

EXAMINER	
HSU, G	
ART UNIT	PAPER NUMBER
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023913
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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/148,973	Applicant(s) Greenamyre et al.
	Examiner G. Hsu, Ph.D., J.D.	Art Unit 1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *three* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *Mar 20, 2001*.

2a) ☐ This action is **FINAL.** 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-8* is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-3 and 5-7* is/are rejected.

7) ☒ Claim(s) *4 and 8* is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6
18) ☐ Interview Summary (PTO-413) Paper No(s). _____
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other:

DETAILED ACTION

1. A Petition for a One Month Extension of Time, A Request for a Continued Prosecution Application Under 37 C.F.R. § 1.53(d), A Request for Reconsideration and an Information Disclosure Statement, respectively received March 20, 2001 and A Supplemental Information Disclosure Statement received April 12, 2001, were entered respectively as Paper Nos. 20-24.

Status of Claims

2. Claims 1-8 are pending and under examination in the current application.

3. A discussion below is set forth with regard to the status of claim 9:

In the March 20, 2001 Communication, applicants:

[1] have requested that the remarks in the January 4, 2001 Response to the June 30, 2000 Final Office Action be considered in the current round of prosecution;

[2] indicated that claims 1-8 remain pending in the subject application; and that

[3] "In the January 24, 2001 Advisory Action issued in connection with the subject application, the Examiner stated that newly presented generic claim 9 raises new issues. However, applicants did not present claim 9 in their January 4, 2001 Communication and applicants are not presenting claim 9 in the instant Communication."

In response, it is the position of the Examiner that:

[1] remarks in the January 4, 2001 Response to the June 30, 2000 Final Office Action are now under consideration in the current round of prosecution;

[2] claims 1-8 are pending in the instant application; and that

[3] for the record it is noted that an inadvertent reference was made with regard to:

[a] the presentation of claim 9 in the January 4, 2001 Communication,

[b] when the Examiner ***intended to refer*** to the presentation of claim 9 in the Amendment and Response to the June 20, 2000 **Final** Office Action received October 23, 2000;

[c] In light of the foregoing and as applicants **did not request entry** of the October 23, 2000 Amendment and Response (**which includes the recitation of claim 9**):

it is noted for the record that claim 9 has not been entered and therefore is not a pending claim.

Continued Prosecution Application

4. The request filed on March 20, 2001 for a Continued Prosecution Application (CPA) under 37 C.F.R. 1.53(d) based on parent U.S. Application No. 09/291,524 is acceptable and a CPA has been established. ***An action on the CPA follows.***

5. For the record, it is noted that:

[1] the parent U.S. Appln. No. 09/148,973 was abandoned in favor of the current continued prosecution application;

[2] as indicated in the applicants' CPA request, the January 8, 2001 Communication in Response to June 20, 2000 Final Office Action and November 16, 2000 Advisory Action has been entered and is under consideration; and

[3] an Examiner's response to the aforementioned January 8, 2001 Communication is set forth below.

6. The text of statutory sections of Title 35 of the U.S.Code not recited in the instant action are set forth in a previous Office Action.

Outstanding Objection(s) and/or Rejection(s)

7. Note that: Claims 4 and 8 have been indicated to be allowable subject matter in the September 28, 1999 Office Action.

The objection of Claims 4 and 8 as being dependent upon a rejected base claim and would be allowable if rewritten in independent form to include all limitations of the base and any intervening claims are maintained for the following reasons of record.

Claims 4 and 8 are limited to administration of 3-(2-chlorophenyl)-2-[2-(6-diethylaminomethyl-pyridin-2-yl)-vinyl]-6-fluoro-3H-quinazolin-4-one. That compound is not taught in the prior art, but appears for the first time in the literature in one or more of Applicants' disclosures, all of which were published less than one year prior to the critical date. Thus, 3-(2-chlorophenyl)-2-[2-(6-diethylaminomethyl-pyridin-2-yl)-vinyl]-6-fluoro-3H-quinazolin-4-one was not known to be an AMPA receptor antagonist prior to the critical date.

8. The rejection of claims 1-3 and 5-7 under 35 U.S.C. 103(a) as being unpatentable over Arnold et al. (U.S. Patent No. 5,670,516, Filed: June 1, 1995, Issued: December 29, 1987) are maintained for the following reasons of record.

The claimed invention is directed to a method of treating dyskinesia, which comprises administering to a mammal an amount of an AMPA receptor antagonist that is effective in treating said dyskinesia.

Arnold et al teach a method of treating neurological disorders by administering a compound that blocks (or antagonizes) AMPA receptors. It is acknowledged that Arnold et al

exemplify different AMPA antagonist compounds. However, instant claims 1-3 and 5-7 are not limited to particular AMPA antagonists.

In view of the above, Arnold et al. ***differs*** from the claimed invention in that the claimed invention is drawn to treating a more specific neurological disorder, namely dyskinesia associated with dopamine agonist therapy (claims 1 and 5), wherein the therapy comprises administration of L-dopa or L-dopa in combination with an inhibitor of peripheral dopadecarboxylase (claims 2 and 6), wherein the peripheral dopadecarboxylase is cardidopa or benserazide (claims 3 and 7).

A person of ordinary skill in the art would have been motivated to use AMPA antagonists to treat dyskinesia, in view of the patent's entire disclosure, because the Arnold et al. teach that dyskinesia is among those neurological disorders responsive to AMPA antagonists.

A person of ordinary skill in the art would have had a reasonable expectation of success to use AMPA antagonists to treat dyskinesia, in view of the patent's entire disclosure, because the Arnold et al. teach that dyskinesia is among those neurological disorders responsive to AMPA antagonists.

It would have been ***prima facie obvious*** to a person of ordinary skill in the art to use AMPA antagonists to treat dyskinesia, in view of the patent's entire disclosure, because Arnold et al teach that blocking AMPA receptors is an effective way to treat a variety of disorders, including dyskinesia (see, for example, claims 24 and 29).

In the March 27, 2000 and January 8, 2001 Communications, applicants' assert that:

[1] the claimed method is not obvious from the teachings of the Arnold et al. reference, because:

[a] it does not teach a method of treating dyskinesia, wherein said dyskinesia is caused by dopamine agonist therapy;

[b] that it would not be obvious to use compounds indicated for treating dyskinesias associated with glutamate toxicity to treat dyskinesias associated with dopamine therapy; and

[c] the method taught in the Arnold et al. reference is directed to a method for the treatment of tardive dyskinesia associated with dopamine **antagonist** therapy is different from the claimed method which is directed to dyskinesias caused by dopamine **agonist** therapy.

In response, it is the position of the Examiner that:

[a] applicant's arguments have been fully considered, but they are not persuasive for the following reasons.

It is noted again that substantially similar arguments were previously made on the record.

[b] for the record, it is noted that:

[1] the claimed invention is directed to a method of treating dyskinesias associated (i.e., a result of or caused) by dopamine ***agonist*** therapy, which comprises the administration of an **antagonist compound**,

and

[2] the Arnold et al. reference also is directed to a method of treating neurological disorders, including different dyskinesias, which comprises the administration of a antagonist compound.

In light of the foregoing, the Arnold et al. reference renders obvious the claimed invention, because:

a method for treating dyskinesias, whether or not associated with dopamine agonist or antagonist therapies, **which comprises the administration of an antagonist compound would necessarily operate by the same biological mechanism of action**

Moreover, mechanisms of action as to how a particular condition, disease, etc. are not afforded patentable weight under the current U.S. law.

As the claimed invention includes administering to a mammal an amount of some **non-specified AMPA receptor antagonist**, one of ordinary skill in the art would maintain that regardless of the causative means by which such dyskinesia conditions result in any mammal, all mechanisms of biological action of the such AMPA receptor antagonists when used to treat dyskinesia conditions would invariably be inherent in mammals.

[c] The Arnold reference does disclose a method of treating dyskinesia, which comprises administering to a mammal an amount of a compound that is an AMPA receptor antagonist, via the blocking AMPA receptors by administration of AMPA receptor antagonists. Moreover in their March 27, 2000 Communication, applicants acknowledge that the Arnold et al. reference teaches that the use of a neuroprotective agent, as an AMPA receptor antagonist is "useful in treating" neurological conditions ,which include tardive dyskinesia.

[d] In response to applicant's argument that it would not be obvious to use compounds indicated for treating dyskinesias associated with glutamate toxicity or to treat dyskinesias associated with dopamine therapy, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re*

Casey, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In light of the foregoing, the rejection is maintained for reasons of record and is deemed proper.

9. The rejection of claims 1-3 and 5-7 under 35 U.S.C. 103(a) as being unpatentable over Klockgether et al. (Annals of Neurology, 1991, 30, 717-723) are maintained for the following reasons of record.

Klockgether et al. teach that blocking AMPA receptors (by administering AMPA receptor antagonists) may provide a new strategy for treating Parkinson's disease (PD).

In view of the above, Klockgether et al. ***differs*** from the claimed invention in that the claimed invention is drawn to treating dyskinesia associated with L-dopa therapy.

A person of ordinary skill in the art would have been motivated to develop a method for treating dyskinesia associated with L-dopa therapy, because: (1) Klockgether et al suggest treating PD patients who are on L-dopa therapy, as they suggest that AMPA antagonists can "potentiate" the actions of l-dopa, but reduce tremor associated therewith. (see, page 18, column 2); and (2) Klockgether et al suggest dyskinesia associated with l-dopa therapy, because Parkinson disease symptoms, include tremors, a main symptom that results in dyskinesia.

A person of ordinary skill in the art would have had a reasonable expectation of success to develop a method for treating dyskinesia associated with L-dopa therapy, because (1) Klockgether et al suggest treating PD patients who are on L-dopa therapy, as they suggest that

AMPA antagonists can "potentiate" the actions of l-dopa, but reduce tremor associated therewith. (see, page 18, column 2); and (2) Klockgether et al suggest dyskinesia associated with l-dopa therapy, because Parkinson disease symptoms, include tremors, a main symptom that results in dyskinesia.

It would have been ***prima facie obvious*** to a person of ordinary skill in the art to modify the process implied by Klockgether et al. in light of the foregoing.

In the March 27, 2000 and January 8, 2001 Communications, applicants assert that:

[1] the claimed method is not obvious from the teachings of the aforementioned reference, because:

[a] the passage cited by the Examiner in the previous action indicating that "AMPA receptor antagonists reduce tremor associated with L-dopa" could not be located by applicants;

[b] it only discusses side effects that might have been observed with the AMPA drug and does not address any l-dopa side effects; and that

[c] "administering NBQX (an AMPA receptor antagonist) to a patient suffering dyskinesia from L-dopa therapy might actually be considered counterintuitive from Klockgether et al., since one might expect NBQX to exacerbate the dyskinesia side effect of l-dopa, since Klockgether et al. indicates that NBQX potentiates the effect of l-dopa (see, applicants response page 3, lines 25-28)"; and

In response, it is the position of the Examiner that:

[a] applicant's arguments have been fully considered, but they are not persuasive for the following reasons:

It is noted again that substantially similar arguments were previously made on the record.

for the record, it is noted that:

[1] the claimed invention is directed to a method of treating dyskinesias associated (i.e., a result of or caused) by dopamine ***agonist*** therapy, which comprises the administration of an **antagonist compound**,

and

[2] the Arnold et al. reference also is directed to a method of treating neurological disorders, including different dyskinesias, which comprises the administration of a antagonist compound.

In light of the foregoing, the Arnold et al. reference renders obvious the claimed invention, because:

a method for treating dyskinesias, whether or not associated with dopamine agonist or antagonist therapies, **which comprises the administration of an antagonist compound would necessarily operate by the same biological mechanism of action**

Moreover, mechanisms of action as to how a particular condition, disease, etc. are not afforded patentable weight under the current U.S. law.

As the claimed invention includes administering to a mammal an amount of some **non-specified AMPA receptor antagonist**, one of ordinary skill in the art would maintain that regardless of the causative means by which such dyskinesia conditions result in any mammal, all mechanisms of biological action of the such AMPA receptor antagonists when used to treat dyskinesia conditions would invariably be inherent in mammals.

[c] The Examiner notes that an inadvertent page number misidentification lead to confusion with regard to the specific

Klockgether et al. citation (i.e., stating that treating PD patients who are on L-dopa therapy, wherein AMPA antagonists can "potentiate" the actions of l-dopa, but reduce tremor associated therewith). The passage cited by the Examiner is located on page 720, col. 2, lines 1-15 of the reference, not on page 18, column 2 of the facsimile transmission page from the Pfizer library.

[b] and [c] applicants' contentions are not found persuasive with regard to that Klockgether et al.:

[1] only discusses side effects that might have been observed with the AMPA drug without addressing L-dopa side effects; and that

[2] administration of the NBQX receptor antagonist would be expected to exacerbate the dyskinesia side effect of l-dopa.

With respect to the Klockgether reference, the Examiner maintains that applicants have mischaracterized the teachings discussed therein and notes:

"the principal finding of [Klockgether's] research are that the selective AMPA receptor antagonist NBQX has potent anti-parkinsonian effects . . .[in] that it ***potentiates the actions of L-dopa*** (see, page 720, col. 2, lines 11-15) ***and is effective in reducing the overall activity of neuronal activity*** (see, page 717, lines 17 to page 718, lines 1-2) ***associated with Parkinson's disease***, such as dyskinesia, tremors, etc, due to clockade of excitatory synaptic transmission by AMPA receptor antagonists (see, abstract, line 12-13)."

In particular, Klockgether et al. teaches that:

[1] co-administration an AMPA receptor antagonist and L-DOPA were administered to said mammals to reduce symptoms typically associated with Parkinson's disease, including tremors and dyskinesia

(i.e. NBQX, a AMPA receptor antagonist with a selective affinity for AMPA receptors, with therapeutic effects related only to AMPA receptor blockade was administered in combination with L-dopa (i.e., in l-dopa agonist therapy; see, e.g., page 719, lines 7-11 and Fig. 1) to mammals, (see, page 718, col. 1, lines 2-4 and page 721, col. 2, lines 1-10);

[2] wherein the AMPA receptor antagonist **potentiates or makes l-dopa more effective** in the treatment of Parkinson's disease symptoms, because it reduces and/or eliminates side effects associated with the administration of either antagonist or L-dopa drug, such as dyskinesias (see, page 720, col. 1, lines 8-10);

[3] typical parkinsonian features (tremor, posture, gait, etc.) and drug related side effects (such as dyskinesias, vomiting and psychological disturbances) ***were not observed in laboratory animals*** (see, page 718, col. 2, lines 12-16) based upon the combination therapy of antagonist and L-dopa; and that

[4] selective AMPA receptor antagonists have recently been reported to prevent neurotoxicity of L-dopa in an in vitro test system and they may therefore ***prevent some long term adverse effects of L-dopa treatment*** (see, page 723, col. 1, lines 6-10).

Moreover, applicants' instant disclosure, defines the phrase "dyskinesia associated with dopamine agonist therapy" to mean ***"any dyskinesias which accompanies, or follows in the course of, dopamine agonist therapy, or which is caused by, related to, or exacerbated by dopamine agonist therapy, wherein dyskinesia and dopamine therapy are defined therein*** (see, applicants specification, page 3, lines 20-24 and page 2, lines 32-40 to page 3, line 1-19)." Applicants admission in their response further support the fact that in L-dopa agonist therapy "NBQX (a selective AMPA antagonist) potentiates the actions of L-dopa and was not observed to produce apparent side effects (dyskinesias, vomiting or psychological disturbances) at the doses tested."

In light of the foregoing, Klockgether discusses side effects associated from either or both AMPA receptor antagonists or L-dopa, alone or in combination (see, experimental discussion section and Fig. 1, results of administration of L-dopa,

alone or with AMPA receptor antagonist); and that [2] administration of the NBQX receptor antagonist reduces the side effects of L-dopa administration, including dyskinesias.

In light of the foregoing, the rejection is maintained for reasons of record and is deemed proper.

10. The rejection of claims 1-3 and 5-7 under 35 U.S.C. 103(a) as being unpatentable over Stella et al. (Annals of Neurology, 1996, 39, 574-578) in view of Klockgether et al. (Annals of Neurology, 1991, 30, 717-723) are maintained for the following reasons of record.

Stella et al. teaches administering glutamate antagonists to treat dyskinesias associated with l-dopa therapy in Parkinson's disease.

In view of the above, Stella et al. ***differs*** from the claimed invention in that the claimed invention call for administration of an AMPA receptor antagonist as the glutamate antagonist.

A person of ordinary skill in the art would have been motivated to make the aforementioned substitution because, Klockgether et al teach that both AMPA antagonists and NMDA antagonists are glutamate receptor antagonists (see, page 1, column 2).

A person of ordinary skill in the art would have had a reasonable expectation of success to make the aforementioned substitution, because Klockgether et al teach that both AMPA antagonists and NMDA antagonists are glutamate receptor antagonists (see, page 1, column 2).

It would have been ***prima facie obvious*** to a person of ordinary skill in the art to modify the teaching of Stella et al. with the teachings of Klockgether et al. to use AMPA antagonists as the glutamate receptor antagonists, rather than the NMDA receptor antagonist.

In the March 27, 2000 Communication, applicants assert that:

[1] the claimed method is not obvious from the teachings of the aforementioned reference, because:

> [1] Stella teaches that [1] dyskinesias resulting from l-dopa treatment are limited to NMDA receptor antagonists; and that [2] any glutamate antagonist other than an NMDA antagonist can be used against dyskinesias induced by l-dopa treatment; and
>
> [2] Klockgether et al. does not compensate for this deficiency, because it was published prior to Stella et al. and merely demonstrates that AMPA receptor antagonists were available prior to the Stella et al. reference.

In response, it is the position of the Examiner that:

[a] applicant's arguments have been fully considered, but they are not persuasive for the following reasons:

It is noted again that substantially similar arguments were previously made on the record.

[b] for the record, it is noted that:

[1] the claimed invention is directed to a method of treating dyskinesias associated (i.e., a result of or caused) by dopamine ***agonist*** therapy, which comprises the administration of an **antagonist compound**,

and

[2] the Arnold et al. reference also is directed to a method of treating neurological disorders, including different dyskinesias, which comprises the administration of a antagonist compound.

In light of the foregoing, the Arnold et al. reference renders obvious the claimed invention, because:

a method for treating dyskinesias, whether or not associated with dopamine agonist or antagonist therapies, **which comprises the administration of an antagonist compound would necessarily operate by the same biological mechanism of action**

Moreover, mechanisms of action as to how a particular condition, disease, etc. are not afforded patentable weight under the current U.S. law.

As the claimed invention includes administering to a mammal an amount of some **non-specified AMPA receptor antagonist**, one of ordinary skill in the art would maintain that regardless of the causative means by which such dyskinesia conditions result in any mammal, all mechanisms of biological action of the such AMPA receptor antagonists when used to treat dyskinesia conditions would invariably be inherent in mammals.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Although the aforementioned references were separately argued by the applicants, it is noted by the Examiner that: [a] the combined teaching of those references bolsters the obviousness to use AMPA receptor antagonist as the glutamate antagonist, because one of Klockgether et al. teaches that the antagonists used therein are a selective antagonist of the AMPA subtype of glutamate receptor

and both AMPA antagonists and NMDA antagonists are glutamate receptor antagonists (see, page 717, abstract, line 4-5 and col. 2).

In light of the foregoing, the rejection is maintained for reasons of record and is deemed proper.

New Grounds of Rejection

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Chenard et al., claims 1-10 of U.S. Patent No. 6,136,812 (herein referred to as the U.S. '812 Patent), Filed: September 4, 1998; Issued: October 24, 2000.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the U.S. '812 Patent and the instant application are directed to: methods for treating dyskinesias associated with agonist

therapy in a mammal, which comprises administering to said mammal a compound, which is an antagonist of the AMPA receptor.

The U.S. '812 Patent is directed to the following a method for treating dyskinesias associated with agonist therapy in a mammal, which comprises administering to said mammal a compound, as defined therein by the specific chemical compounds in the claims 1-10, col. 20, lines 60-67 to col. 42 and in the corresponding specification, cols. 2, lines 30-67 to col. 18, as which are antagonists of the AMPA receptor.

The instant application is directed generally to a method for treating dyskinesias associated with agonist therapy in a mammal, which comprises administering to said mammal a compound, which is an antagonist of the AMPA receptor.

In view of the above, the instant claims differ from: the U.S. '812 Patent in that it does not specifically claim the use of specific compound species administered or used in methods for treating dyskinesias associated with agonist therapy in a mammal, which comprises administering to said mammal a compound, which is an antagonist of the AMPA receptor.

However, the subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as both are directed to methods for

treating dyskinesias associated with agonist therapy in a mammal, which comprises administering to said mammal a compound, which is an antagonist of the AMPA receptor.

A person of ordinary skill in the art would have been motivated to develop: the methods of the instant application, because of those methods for treating dyskinesias associated with agonist therapy in a mammal, which comprises administering to said mammal a compound, which is an antagonist of the AMPA receptor are taught in the U.S. '812 Patent.

In light of the foregoing, a person of ordinary skill in the art would have had a reasonable expectation of success in developing methods for treating dyskinesias associated with agonist therapy in a mammal, which comprises administering to said mammal a compound, which is an antagonist of the AMPA receptor, because such methods are taught by the U.S. '812 Patent.

It would have been prima facie obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of the instant application in view of the teachings of the U.S. '812 Patent.

Status of Claims

13. No claims are allowed in the above-identified application.

Conclusion

14. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Grace C. Hsu, Ph.D., J.D., whose telephone number is (703) 308-7005. The Examiner may be reached during normal business hours, Monday through Friday from 8:30 am to 5:30 pm (EST). A message may be left on the Examiner's voice mail.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Jyothsna A. Vencat, Ph.D. may be reached at (703) 308-2439. The fax number assigned to Group 1627 is (703) 305-4242. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1627 receptionist whose telephone number is (703) 308-0196.

BENNETT CELSA
PRIMARY EXAMINER

Actng SPE

Grace C. Hsu, Ph.D., J.D.

May 17, 2001

5/18/01